

REMARKS

In the final Office Action dated September 20, 2007, claims 1-11, 13 and 19-24 were indicated as pending, and rejected. Applicants respectfully assert that claims 1-11, 13, 15, 16 and 19-24 are pending, where claims 1, 7 and 13 are the independent claims. Reconsideration of the final rejection of claims 1-11, 13, 15, 16 and 19-24 is respectfully requested in view of applicants' arguments below.

Response Under 35 USC §103(a)

Claims 1-11, 13, 15, 16 and 19-23 were rejected under 35 U.S.C. 103 as being unpatentable over US Patent No. 5,351,302 to Leighton, et al. (Leighton) in view of US Patent No. 5,903,652 to Mital (Mital), and further in view of US Pending Patent Application Serial No. 2002/0128940 to Orrin (Orrin); claims 1, 7 and 13 are the independent claims. For the reasons discussed below, claims 1-11, 15, 16 and 19-24 patentably distinguish over Leighton in combination with Mital and Orrin, and are allowable. The Examiner is thus asked to reconsider and to withdraw the final rejection and to allow these claims.

Generally, applicants independent claims 1, 7 and 13, and the claims that depend from these independent claims patentably distinguish over the Leighton, Mital and Orrin because none of the cited references show or suggest the feature, in a method of digitally managing the transfer title to financial instruments between a third party emitter, a first party owner and a second party transferee, where the third party emitter issues to the owner a title for a financial instrument, the title including (i) a message describing the title and how to contact the emitter, and (ii) a digital signature of the emitter, the owner transferring ownership of the financial instrument to the second party transferee, including the owner, using a public

signature scheme of the owner, signing the title by appending a message to the title, and that the message includes a public part of a signature scheme of the second party transferee.

The Examiner indicates that Leighton presents a method of digitally managing the transfer of financial instruments between a third-party emitter, a first party owner and a second party transferee. Applicants respectfully disagree. Leighton discloses a system for preventing counterfeiting or otherwise illegal use of documents. In the Leighton system, a title is provided with an identifier uniquely associated with the personal or real property that is the subject of the title, and information directly or indirectly identifying the owner of the property. Applicants have examined Leighton's Abstract, Leighton's col. 1, line 1-line 16, and do not find a method of digitally managing the transfer of financial instruments between a third-party emitter, a first party owner and a second party transferee.

While the Examiner asserts that Leighton at col. 1, lines 35-68 discloses that a third party emitter issues to the owner a title for a financial instrument, the title including (i) a message describing the title and how to contact the emitter, and (ii) a digital signature of the emitter, applicants do agree that Leighton discloses same as asserted by the Examiner. The cited text states that Leighton creates secure titles including an identifier uniquely associated with personal or real property to be identified, and information directly or indirectly identifying the legal owner of the title. The identifier, for example, a vehicle identification number for title to a motor vehicle, and information either directly or indirectly identifying the legal owner is concatenated into a data string that is digitally signed using a secret key of a public cryptosystem pair.

To verify title, a transaction terminal uses a corresponding public key to decrypt the data string. Leighton at col. 1, lines 35-68, however, does not disclose a third party emitter

issuing to an owner a title for a financial instrument including (i) a message describing the title and how to contact the emitter, and (ii) a digital signature of the emitter.

While the Examiner further asserts that Leighton at col. 2, lines 51-68, discloses (A.) the owner transferring ownership of the financial instrument to another person, and (B.) the owner, using a public signature schema of the owner, signing the title using a public signature scheme of the owner and appending to the title a public part of a signature scheme of said other person (i.e., the third party transferee), applicants do not find the claim elements at the cited portions of Leighton. Applicants read the cited Leighton text as merely discussing digital signatures and public-key cryptosystems and how a digital signature can be used to bind information to a title. There is no teaching or suggestion of having an owner transfer ownership of a financial instrument to a second party transferee, including that the owner, using his or her public signature scheme, appending a message to the title, where this message includes a public part of a signature scheme of the transferee.

The Examiner also argues that Leighton does not explicitly disclose a second party transferee, appending a message to the title including a public part of a signature scheme, and a third party emitter issuing to the owner a title for a financial instrument and a message describing the title and how to contact the emitter, but that Mital discloses a third party emitter issuing to the owner a title for a financial instrument and a message describing the title and how to contact the emitter, at col. 2, lines 22-62, col. 22, line 24-col. 23, line 20 and col. 27, lines 17-53, to prepare a secure authenticated digital document with digital signature to be transmitted over the Internet, and that it would have been obvious to modify Leighton, and include a third-party emitter issuing to the owner a title for a financial instrument and a message describing the title and how to contact the third-party emitter to prepare a authenticated digital document for sending over the Internet.

Applicants respectfully disagree. Mital does not teach a third party emitter issuing to the owner of title for a financial instrument and a message describing the title and how to contact the emitter at col. 2, lines 23-62, col. 24, line 24-col. 23, line 20, and col. 27, lines 17-53. Hence, combining Leighton with Mital does not realize the elements of applicants' independent claims including the owner transferring ownership of the financial instrument to the second party transferee, including the owner, using a public signature scheme of the owner, signing the title by appending a message to the title, said message including a public part of a signature scheme of said second party transferee. There is no teaching or suggestion in the cited portion of Leighton (or in any other portion of this reference) that can be remedied by combining with Mital, of having the owner, using his or her public signature scheme, append a message to the title, where this message includes a public part of a signature scheme of the transferee.

The Examiner continues that Leighton discloses transferring ownership, but that the two-by combination of Leighton and Mital does not explicitly disclose a second party transferee, and appending a message to title, the message including a public part of a signature scheme of the second party transferee. The Examiner then asserts that Orrin discloses a second party transferee (assignee), and appending a message to the title that has a public part (par. 004, 015, 030), and that it would therefore have been obvious to modify the Leighton as modified by Mital combination to include appending a message to title that has a public part, as disclosed by Orrin.

Applicants respectfully disagree. The cited portion of Orrin merely recites having the owner, using his or her public signature scheme, append a message to the title, where this message includes a public part of a signature scheme of the transferee. Applicants' independent claims include the limitation that the owner transferring ownership of the financial

instrument to the second party transferee, the owner, using a public signature scheme of the owner, signing the title by appending a message to the title, said message including a public part of a signature scheme of said second party transferee.


Hence, combining Leighton with Mital, and combining the hypothetical Leighton/Mital combination with Orrin, does not remedy the shortcomings of Leighton, or Leighton combined with Mital, or Leighton combined with Mital combined with Orrin, with respect to the independent claim language. That is, combining Leighton, Mital and Orrin still would not realize a method such as that set forth in applicants' independent claims, including a third party emitter issuing to the owner a title to a financial instrument, the title including a message describing the title and how to contact the emitter, and a digital signature of the emitter, the owner transferring ownership of the financial instrument to the second party transferee, including the owner, using a public signature scheme of the owner, signing the title by appending a message to the title, said message including a public part of a signature scheme of said second party transferee, a limitation in each of claims 1, 7 and 13.

Due to the above-discussed differences between claims 1, 7 and 13 and the Leighton, et al., Mital and Orrin combination, and because of the advantages associated with these differences, claims 1, 7 and 13 patentably distinguish over the prior art and are allowable. Claims 2-6 and 19-24, are dependent from claim 1 and are allowable therewith; claims 8-11 are dependent from claim 7 and allowable therewith; and claims 15, 16 depend from claim 13 and are allowable therewith. The Examiner is, accordingly, respectfully asked to reconsider and to withdraw the rejections of claims 1-11, 13, 15, 16 and 19-24 under 35 U.S.C. §103 (a) by the Leighton, Mital and Orrin combination, and to allow the claims.

The other references of record have been reviewed, and these other references, whether considered individually or in combination, also do not disclose or suggest this feature of the present invention.

For the reasons discussed above, the present application, including pending claims 1-11, 13, 15, 16 and 19-24, is now in condition for allowance, a notice of which is requested. If the Examiner believes that a telephone conference with applicants' attorneys would be advantageous to the disposition of this case, the Examiner is asked to telephone the undersigned.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'JFV', is written over the printed name.

John F. Vodopia
Registration No. 36,299
Attorney for Applicants

SCULLY, SCOTT, MURPHY & PRESSER, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

JFV: tb